

REMARKS

Claims 8-17 are pending in this application. In the Final Office Action,¹ the Examiner rejected claim 8 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement; rejected claims 8-11 and 13 under 35 U.S.C. § 102(b) as being anticipated by Iijima (U.S. Patent No. 5,365,045); rejected claims 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of Chapters 2 and 24 of *Applied Cryptography* by Schneier; and rejected claims 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of Grimonprez et al. (U.S. Patent No. 5,473,690).

I. REJECTION OF CLAIM 8 UNDER § 112, ¶1

Applicant respectfully traverses the rejection of claim 8 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. In rejecting claim 8 under 35 U.S.C. § 112, first paragraph, the Examiner contends that “the specification does not describe the validity data as stored (or not stored) in the device as being one and the same as the validity data in the command message.” See Final Office Action, page 4. Applicant respectfully disagrees with the Examiner’s assertion. In particular, Applicant notes that the specification² at, for example, page 2, line 19 to page 3, line 7, enables the recited features of claim 8.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Final Office Action.

² In making reference to the specification, it is to be understood that Applicant is in no way intending to limit the scope of the claims to the exemplary embodiments described in the specification. Rather, Applicant expressly affirms that it is entitled to have the claims interpreted broadly, to the maximum extent permitted by statute, regulation and applicable case law.

The Examiner also contends that, based on pages 10 and 11 of Applicant's disclosure, "it is not clear exactly what is the claimed validity data of the command message that is being identified by the first determining means." See id. Applicant disagrees and respectfully submits that "the pending claims must be given their broadest reasonable interpretation consistent with the specification." See MPEP § 2111. As noted above, the recitations of claim 8 are enabled by the specification at least at page 2, line 19 to page 3, line 7. For at least the above reasons, Applicant respectfully submits that the specification enables claim 8 to one of ordinary skill in the art. Therefore, Applicant requests that the Examiner withdraw the rejection under 35 U.S.C. § 112, first paragraph.

II. REJECTION OF CLAIMS 8-11 AND 13 UNDER § 102(b)

Applicant respectfully traverses the rejection of claims 8-11 and 13 under 35 U.S.C. § 102(b) as being anticipated by Iijima. In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131.

Claim 8 recites a combination including, among other things, "first means for writing or rewriting data in the nonvolatile memory after receiving the command

message when the first determining means determines that the command message does not include the validity data and the second determining means determines the validity data is not stored in the nonvolatile memory.” Iijima does not teach at least this element of claim 8.

In particular, in the Final Office Action, the Examiner contends that Iijima teaches that “when an input message is received, a determination step determines if the input message is input command data for a particular action (such as DF definition command data).” See Final Office Action at page 3. The Examiner apparently associates the DF definition command data in Iijima with the claimed “validity data” for a security function. DF definition command data, however, is used to check whether a memory cell has malfunctioned. See col. 5, lines 64 to col. 6, lines 18. Such checking, however, does not constitute a security function. The Examiner’s assertions notwithstanding, Iijima does not teach “first means for writing or rewriting data in the nonvolatile memory . . . when the first determining means determines that the command message does not include *the validity data for the security function* and the second determining means determines *the validity data* is not stored in the nonvolatile memory,” (emphasis added) as recited in claim 8. Accordingly, since Iijima does not teach or disclose at least this element of claim 8, the reference does not anticipate the claim. Therefore, the Examiner should withdraw the rejection of claim 8 under 35 U.S.C. § 102(b).

Dependent claims 9-11 and 13 depend from claim 8. For at least the same reasons discussed above, dependent claims 9-11 and 13 are also allowable over Iijima. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 9-11 and 13.

III. REJECTION OF CLAIMS 12 AND 14 UNDER § 103(a)

Applicant respectfully traverses the rejection of claims 12 and 14 under 35 U.S.C. § 103(a) as being unpatentable over lijima in view of Chapters 2 and 24 of *Applied Cryptography* by Schneier. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

Claims 12 and 14 depend indirectly from allowable claim 8. In the Final Office Action, the Examiner applies Schneier because the reference allegedly discloses "several general protocols to verify data using digital signatures and hashes." See page 7. However, even if the Examiner's allegations were correct, which Applicant does not concede, Schneier does not disclose or suggest at least "first means for writing or rewriting data in the nonvolatile memory . . . when the first determining means determines that the command message does not include the validity data for the security function and the second determining means determines the validity data is not stored in the nonvolatile memory," as recited in claim 8 and required by claims 12 and 14. Accordingly, Schneier does not make up for the above described deficiencies of

Iijima. Claims 12 and 14 are therefore allowable over the applied references at least due to their dependence from claim 8.

IV. REJECTION OF CLAIMS 15-17 UNDER § 103(a)

Applicant respectfully traverses the rejection of claims 15-17 under 35 U.S.C. § 103(a) as being unpatentable over Iijima in view of Grimonprez.

Claims 15-17 depend indirectly from allowable claim 8. In the Final Office Action, the Examiner alleges Grimonprez “discloses a secure method for loading a plurality of applications no to a microprocessor of an IC card wherein each application has a corresponding security program.” See page 8. However, even if the Examiner’s allegations were correct, which Applicant does not concede, Grimonprez also does not teach or suggest at least “first means for writing or rewriting data in the nonvolatile memory . . . when the first determining means determines that the command message does not include the validity data for the security function and the second determining means determines the validity data is not stored in the nonvolatile memory,” as recited in claim 8. Accordingly, Grimonprez does not overcome the shortcomings of Iijima discussed above and claims 15-17 are also allowable at least due to their dependence from claim 8.

CONCLUSION

Applicant respectfully requests that the Examiner consider the response under 37 C.F.R. § 1.116, placing the pending claims in condition for allowance. In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 18, 2006

By: Anthony Y. Hwang, Reg. No. 53,232
for Richard V. Burgujian
Reg. No. 31,744